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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 020967-002010US | |
| I hereby certify that this correspondence is being filed via EFS-Web with the United States Patent and Trademark Office on <u>May 31, 2007</u> . TOWNSEND and TOWNSEND and CREW LLP By: <u>/Janet L. Newmaker/</u> Janet L. Newmaker | | Application Number 09/874,795 | Filed June 5, 2001 |
| | | First Named Inventor Geoffrey R. Hird | |
| | | Art Unit 2135 | Examiner Paula W. Klimach |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,358</u>. <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____ </div> <div style="width: 45%; text-align: right;"> <u>/Irvin E. Branch/</u> Signature <u>Irvin E. Branch</u> Typed or printed name <u>303-571-4000</u> Telephone number <u>May 31, 2007</u> Date </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p> | | | |
| <input checked="" type="checkbox"/> *Total of <u>1</u> form is submitted. | | | |

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PATENT
Attorney Docket No.: 020967-002010US

TOWNSEND and TOWNSEND and CREW LLP

By: /Janet L. Newmaker/
Janet L. Newmaker

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Geoffrey R. Hird

Application No.: 09/874,795

Filed: June 5, 2001

For: Method And Apparatus For
Secure Cryptographic Key
Generation, Certification And Use

Customer No.: 20350

Confirmation No.: 5815

Examiner: Paula W. Klimach

Art Unit: 2135

PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection for the above-identified application. A response after final was filed on April 2, 2007. No amendments to the claims are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated herein.

REMARKS/ARGUMENTS

The Applicant respectfully requests review of all pending rejections because the Office Action has not established a prima facie case of obviousness with respect to any rejection. The cited references do not teach or suggest the claim elements and the Office Action has not provided a motivation that would lead one of skill in the art to combine the references to make the Applicant's claimed invention.

All Limitations Not Taught Or Suggested

The Advisory Action confirms that Zingher is cited for teaching "a seed-based data generation module . . . configured to generate an output datum . . . , wherein the output datum is a function of the input access code, and . . . wherein for at least one input access code not equaling said user's access code, said seed-based data generation module generates an invalid output datum having said appearance of said user's confidential datum." The final Office Action and Advisory Action appear to equate the Applicant's claimed "output datum" to Zingher's message displayed on an ATM stating "Your Request Exceeds the Maximum Allowable Withdrawal at this Machine." The final Office Action states that "the output datum has the appearance of the user's confidential datum since the system does not provide the actual amount that is available and there appears like the confidential datum, but is invalid" (final Office Action, p. 4). The Advisory Action states that this output datum has the appearance of the user's confidential datum "because it is not the correct value of the funds available are not the funds shown, instead it is a value presented as a response to the false PIN and is therefore a function of the false PIN" (Advisory Action, p. 2). Neither of these statements explain how a false message has the appearance of the user's confidential datum. Hence, the Applicant maintains that the cited references do not teach or suggest "an invalid output datum having said appearance of said user's confidential datum." All pending independent claims are, therefore, believed to be allowable, at least for this reason.

If, however, the rejection is maintained and the interpretation that the displayed message taught by Zingher is equivalent to the Applicant's claimed invalid output datum having

an appearance of the user's confidential datum, then a number of dependent claims are allowable. For example, claims 4, 5, 23 and 34 are allowable because the displayed message does not have the appearance of an asymmetric cryptographic key; claim 6 is allowable because the displayed message does not have the appearance of a symmetric cryptographic key; and claim 15 is allowable because the displayed message does not have the appearance of a private key. Hence, even if the interpretation of an invalid access code having the appearance of the user's confidential datum holds, then claims 4, 5, 6, 15, 23 and 34 should be allowed.

No Motivation to Combine References

The Applicant maintains that there exists no motivation to combine Pavlov and Spratte. Pavlov relates to a device for concealing an account number, Spratte relates to secure communication. One skilled in the art would not be motivated to combine these two references, since the references are directed to different areas of endeavor. The Office Action states that one would be motivated to combine the references because to do so would "create keys that meet export conditions, but are unique enough to make them difficult to hack." The Applicant is unable to determine what this has to do with Pavlov. It appears that this motivation is based on hindsight reasoning provided by the Applicant's specification. Moreover, the record has not established that the alleged motivation existed at the time of the Applicant's invention. Hence, the stated motivation is invalid, and all independent claims are believed to be allowable for at least this additional reason.

Further, no motivation exists to add Zingher to the combination. Zingher is directed to an entirely different endeavor from either Spratte or Pavlov. More importantly, the motivation cited by the Office Action has nothing to do with combining Zingher with Pavlov and/or Spratte to supply the missing elements. Again, the motivation appears to rely on hindsight reasoning provided by the Applicant's specification. Further still, the record has not established that the alleged motivation existed at the time of the Applicant's invention, and all pending claims are believed to be allowable for at least this additional reason.

Conclusion

In view of the foregoing, the Applicant respectfully requests withdrawal of the rejections and issuance of a formal Notice of Allowance.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: May 31, 2007

/Irvin E. Branch/

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